Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUGH E. MCLOONE and JAMES H. CAUTHORN

Appeal No. 2004-1307
Application No. 09/843,724

ON BRIEF

Before KRASS, OWENS, and RUGGIERO, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1, 3, 6, 7, 13-15, 17-22 and 24-30. As of the final rejection claims 2, 4, 5, 8-12, 16 and 23 were canceled, and after the final rejection claims 22 and 24-26 were canceled. Thus, the claims before us are claims 1, 3, 6, 7, 13-15, 17-21 and 27-30.

THE INVENTION

The appellants claim a keyboard which, the appellants state, is for entering data into text and office systems such as computers (specification, page 1, lines 14-15). Claims 1, 7,

15 and 27 are illustrative:

> 1. A keyboard comprising: a number pad, said number pad having a first key cluster including a plurality of digit keys, a plurality of arithmetic operation keys, and a Tab key, said keyboard having a second key cluster including at least a Backspace key, a Left Parenthesis key and a Right Parenthesis key, said second key cluster being directly behind said first key cluster and being spaced within one inch of said first key cluster.
>
> 7. A keyboard comprising:
>
> a number pad, said number pad having a plurality of digit keys, a plurality of arithmetic operation keys, and a Tab key, wherein said plurality of digit keys, said plurality of arithmetic operation keys, and said Tab key are part of a key cluster; wherein said key cluster further includes a Decimal Separator key and an Enter key and a secondary mode Numlock Key; wherein the total number of keys in the key cluster is between 16 and 19.
>
> 15. A keyboard comprising:
>
> an alphanumeric section;
>
> a numeric section having a group of keys including a plurality of digit keys and a plurality of arithmetic operation keys; said numeric section including a Tab key; and a Equals key; wherein said one of said Tab key and said Equals key is disposed in a single key cluster spaced behind a digit key and the other of said Tab key and said Equals key in a secondarily labeled NumLock key.
>
> 27. A computer keyboard comprising: an alphanumeric section, a numeric section, a group of keys in the numeric section, said group of keys in the numeric section having a plurality of digit keys and a plurality of arithmetic operation keys, and a secondarily labeled NumLock key.

THE REFERENCES

Grant	5,119,078	Jun. 2, 1992
Hutchison	5,129,747	Jul. 14, 1992
Willner	5,790,103	Aug. 4, 1998

A. Olsson, "Computer keyboard, has number pad with its own tab key and preferably with extra shift key and space bar," Derwent abstract no. 2000-678455 (© 1999) of SE 9903443A (Sep. 23, 1999).

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 3, 6, 13-15 and 17-21 over Olsson in view of Grant; claim 7 over Hutchison in view of Olsson; and claims 27-30 over Olsson in view of Willner.

OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1, 7, 15 and 27.

Claim 1

Olsson discloses a keyboard comprising a number pad having a first key cluster including a plurality of digit keys, a plurality of arithmetic operation keys, and a Tab key (figure). Directly behind the first key cluster is a rectangle that may be an indication of a second key cluster. *See id*.

Grant discloses a keyboard having a top row of keys that includes a Backspace key, a Left Parenthesis key and a Right Parenthesis key, and extends to the right above a number pad (figure 7).

The examiner argues that Grant's top row of keys is a cluster, and that if the cluster were added to Olsson's keyboard it would extend directly behind Olsson's first key cluster and be spaced within one inch therefrom (answer, pages 10-14). The motivation for making that combination, the examiner argues, would be "to allow the convenience to the user as a typing aids" (answer, page 4).

For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The examiner has not established that Olsson and Grant themselves would have indicated to one of ordinary skill in the art that adding Grant's top row of keys to Olsson's keyboard

would be a convenience to the user as a typing aid. Thus, the record indicates that the examiner combined the references using the appellants' disclosure as a template, which is improper. *See Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1784. Accordingly, we reverse the rejection of claim 1 and claims 3, 6 and 14 that depend directly or indirectly therefrom.

Claim 7

Hutchison discloses a keyboard comprising 1) a number pad that includes a NumLock key and digit keys, the digit keys having a secondary mode, and 2) a key cluster, directly behind the number pad, that includes another NumLock key (figure 1).

The examiner argues that in view of Hutchison's disclosure of keys in the number pad having a secondary mode, it would have been obvious to one of ordinary skill in the art to include in the number pad a secondary mode NumLock key since it has been held that rearranging parts of an invention involves only routine skill in the art (answer, pages 7 and 22).

The examiner has not explained how the modification proposed by the examiner would be a mere rearrangement of parts. Regardless, the examiner is relying upon a *per se* rule that rearranging parts would have been obvious to one of ordinary skill in the art. As stated by the Federal Circuit in *In re*

Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease." To set forth a *prima facie* case of obviousness the examiner must establish that the applied prior art itself would have fairly suggested, to one of ordinary skill in the art, the desirability of the examiner's proposed modification of the prior art, *see Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84, and the examiner has not done so. Consequently, we reverse the rejection of claim 7.

Claim 15

The examiner points out that Olson's keyboard has a NumLock key and a plurality of keys with secondary mode, and argues that it would have been obvious to one of ordinary skill in the art to make one of Olsson's Tab key and Equals key a secondarily labeled NumLock key because it has been held that rearranging parts of an invention involves only routine skill in the art (answer, pages 5-6 and 18). This argument is not persuasive for the reason given above regarding the rejection of claim 7. We therefore reverse the rejection of claim 15 and claims 17-21 that depend directly or indirectly therefrom.

Claim 27

Willner discloses a keyboard having secondarily labeled keys other than a NumLock key (figure 2B).

The examiner argues (answer, pages 20-21):

> While the modified device of Olsson and Willner do not teach "a secondarily labeled NumLock key", Willner teach[es] the use of a plurality of keys with a variety of secondarily labeled function[s] (see Figure 2B of Willner that [is] reproduced below). In view of this teaching, it is clear that the selection for a key to have a specific secondarily labeled function such as NumLock can be determined through obvious routine experimentation so as to provide more convenience to the user as typing aids.

The examiner has not established that Olsson and Willner themselves would have indicated to one of ordinary skill in the art that a secondarily labeled NumLock key would provide more convenience to the user as a typing aid, or that those references would have led one of ordinary skill in the art to a NumLock key through routine experimentation. Consequently, the record indicates that the motivation relied upon by the examiner for including a secondarily labeled NumLock key in Olsson's keyboard comes from the appellants' disclosure rather than coming from the applied prior art and, therefore, that the examiner used impermissible hindsight in rejecting the appellants' claim 27. *See W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553,

220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we reverse the rejection of claim 27 and claims 28-30 that depend directly or indirectly therefrom.

DECISION

The rejections under 35 U.S.C. § 103 of claims 1, 3, 6, 13-15 and 17-21 over Olsson in view of Grant, claim 7 over Hutchison in view of Olsson, and claims 27-30 over Olsson in view of Willner, are reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)	
TERRY J. OWENS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	)	

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